

KSK:dlh 09/27/01 72860
PATENT

Attorney Reference Number 2747-51635
Application Number 09/255107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert B. Harkness and Philip A.
Harkness
Application No. 09/255,107

Art Unit: 1661

Filed: February 22, 1999

For: CLIMBER ROSE PLANT NAMED HARYUP

Examiner: Howard J. Locker

Date: September 27, 2001

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents
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AMENDMENT

This is in response to the Office Action dated August 3, 2001, Paper No. 10.

It is respectfully requested the Notice of Allowability in this application be restored and a patent be issued.

It is submitted for the reasons briefly stated hereafter that the contemplated rejection under 35 USC 102(b) of the subject application is wholly out of order. The rose of the subject application was not on sale or otherwise publicly available in the United States more than one year before the filing date of the subject application. While applications were filed for PBR protection and in some instances Breeders' Rights Grants issued, and the variety was sold in other countries more than one year prior to the filing date of this application, none of these events singly nor together constitute a proper basis for rejection under 35 USC 102(b).

On the basis of the information at hand, it is hereby conceded that the information with respect to the PBR applications and/or registrations cited is correct.

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In addition, it is conceded that the rose variety of the subject application was placed on public sale in the United Kingdom in November, 1992. No sales of the variety, however, were made in the United States more than one year prior to the filing date of the subject application, nor was it offered for sale in the United States more than one year prior to the filing date of the subject application.

Cited in the Office Action was the decision of the United States Court of Customs and Patent Appeals, In re LeGrice, 301 F2d 929, 133 USPQ 365 (CCPA 1962). In that case the court held unanimously, in reversing a decision of the Patent Office Board of Appeals, that publications showing pictures of roses were not publications under 35 USC 102(b) that would raise a bar to granting of a plant patent since the publications were not "enabling" because no one from the description of a rose in a publication, could produce the plant from the disclosure (133 USPQ at 378). That is as true of the disclosures in the PBR applications and grants for the subject rose variety as it was for the plants which were the subject of the plant patent applications being considered in LeGrice.

With respect to the public availability of the plant of the application in some other country of the world more than one year prior to the filing of the application, reliance thereupon in rejection of the application is clearly in violation of 35 USC 102(b). The pertinent part of that section reads as follows:

Section 102: Conditions for Patentability; Novelty and Loss of
Right to a Patent.

A person shall be entitled to a patent unless - ... (b) the invention was ... in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. (Emphasis added)

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The United States Supreme Court in Gandy v. Main Belting Co., 143 US 587 (1891) held that public use abroad more than two years prior to the date of the U.S. application did not constitute a statutory bar even though the statute (Rev. Stat. 4886) at that time did not specify the invalidating public use be "in this country." The Supreme Court noted that the omission of "in this country" from Section 4887 was inadvertent; stating:

Taking all these provisions of the patent law together, we think it was manifestly the intention of Congress that the right of the patentee to his invention should not be denied by reason of the fact that he had made use of it, or put it on sale abroad, more than two years before the application, provided it were not so used or sold in this country. (143 US at 593)

In 1897 the statute was amended to provide the express limitation "in this country" where it has remained ever since.

How can two events, each of which has been ruled not to be a bar to the granting of a patent, combined, constitute a bar?

The record in LeGrice shows, in fact, that in that case both publication and foreign sale of the rose varieties had occurred! The Board of Appeals in its decision dated February 12, 1960, specially noted twice that the foreign sale had no bearing upon the patentability of the roses at issue.

In the record on appeal to the Court of Customs and Patent Appeals, the decision of the Board of Appeals appears at pages 22-27 of the record. The following statements were made by the Board:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the

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United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

Record LeGrice, page 22.

As indicated by his reply brief the most that appellant would concede with respect to the effect of such publication is that it might constitute secondary evidence of the *prior existence* of the actual plant and *sale* thereof so as to constitute a statutory bar. He further suggests that this secondary evidence could almost be accepted with little or no corroboration because the chances of any fraud on the public are extremely remote. As has been stated the use or sale of the plants in a foreign country would be irrelevant. (emphasis in original).

Record LeGrice, pp. 24-25.

(A copy of the entire Decision of Board of Appeals, February 12, 1960, as it appears in the In re LeGrice record is attached as Exhibit A hereto.)

The Court of Customs and Patent Appeals, which had before it the decision of Board of Appeals and most assuredly noted the Board's dismissal of the prior foreign sales (and thus public availability) of the roses at issue, made absolutely no mention of the prior foreign sale as being relevant to a consideration of whether the publication of a rose in a catalogue was an "enabling disclosure." The Court clearly and plainly held that the publication of a description of a plant was not an enabling disclosure and so held although there was evidence in the record of the prior foreign sale of each plant more than one year before the U.S. applications were filed. This decision should be binding upon the Patent Office. If the Court in LeGrice thought that the fact the varieties of the appealed applications were on sale made the disclosures of the cited catalogs "enabling" it would have said so. It did not so hold, but to the contrary, held the publications at issue were not enabling! The opinion specifically notes as follows:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in

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order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

The descriptions of the new roses in the instant publications, are incapable of placing these roses in the public domain by their descriptions when interpreted in the light of the knowledge now possessed by plant breeders. The roses disclosed in the appealed applications are not, therefore, "described in a printed publication" within the meaning of 35 U.S.C. 102(b).

The decision of the Board of Appeals is *reversed*. (133 USPQ @378)

The Court did not affirm the Board and say the sale of the plants noted by the Board to have been made rendered the publications enabling, it, to the contrary, reversed the Board's decision!

The factual situation here is substantially identical to that in LeGrice and the decision therein should be binding.

Moreover, a rejection here under 102(b) would be based upon an improper combination of two events, neither of which is itself a bar under 102(b), namely, a non-enabling publication and a sale in a foreign country. The MPEP explicitly provides:

...for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention, either explicitly or implicitly. MPEP 706.02(a).

The Court of Appeals, Federal Circuit has also explicitly declared this to be the law. See Kalman v. Kimberly-Clark Corp., 713 F2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983):
"...one who seeks such a finding (anticipation under 35 U.S.C. 102) must show that each element of the claim in issue is expressly described...in a single prior art device or practice."; and, Continental Can Co. U.S.A. Inc. v. Monsanto Co., 948 F2d 1264, 1267, 20 USPQ 2d 1746, 1748 (Fed. Cir. 1991); ("When more than one reference is required to establish unpatentability of the

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claimed invention anticipation under § 102 can not be found, and validity is determined in terms of § 103.”)

Moreover, a claimed invention can be rejected under 35 U.S.C. § 103 only upon the basis of “prior art under 35 U.S.C. § 102.” Panduit Corp. v. Dennison Manufacturing Co., 810 F2d 1561, 1 USPQ 1593, 1597 (Fed. Cir. 1987).

The rejection of the claim in the subject application would thus clearly improper since it is based wholly upon two events neither of which is prior art under 35 U.S.C. § 102: a foreign sale and a non-enabling disclosure.

Significantly, the proposed rejection herein is not supported by reference to any decision of the Board of Patent Appeals or the courts (other than Ex parte Thomson) which, contrary to the law and MPEP 706.02(a), upheld a § 102 rejection based upon the combination of two events, neither of which constitutes prior art under 35 U.S.C. § 102.

If this position is upheld any non-enabling publication relating to any invention (e.g., a printed publication in Europe which recites “ABC, Inc. has a circuit having a special array of microprocessors for digital signal processing at double the known speeds. Available as Model ABC, Ver. 1 only in the United Kingdom” coupled with evidence of sale of the product in the UK) would be a bar even if the product had not been offered for sale in the United States. This is far beyond anything contemplated by the patent law.

The rejection of the claim herein clearly would not be in accordance with the controlling law and should not be made.

The policy which this Action threatens to impose would be a serious blow to the nursery industry in the United States and to the U.S. public as a whole in denying the public, as a

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practical matter, access to new plant varieties. The cost of introducing a new, truly useful variety of plant into the United States from a foreign country is a long, expensive process, and one that cannot be expected to be undertaken without some assurance that the investment to be made in a new plant variety can be recovered.

For example, in the case of garden roses, personnel of the assignee herein annually will visit nurseries in Europe and review the garden rose seedlings developed by its various licensors to select varieties that might be promising in the United States. On the average, about 200 varieties are selected annually for consideration.

Budwood for each of the selected such varieties are subsequently shipped to the United States where they must undergo U.S.D.A. inspection and thereafter are delivered to the assignee which undertakes to grow the selected varieties for evaluation, e.g., by budding onto selected rootstock, for propagation in fields that are maintained under U.S.D.A. quarantine for at least two growing seasons. In the winter of year four, if they are disease free, the U.S. Department of Agriculture will release the plants from quarantine whereafter they are available to be further tested. Out of the 200 varieties usually about thirty varieties will have shown enough promise to propagate about fifty plants of each for further examination. The following year, year five, further screening is made to usually about ten varieties and about 500 plants of the ten selected varieties are budded. Test plants are sent to various geographic areas in the United States for regional testing. The following year, year six, the plantings at the test locations are reviewed and usually about four or five varieties still have promise.

The next year, which is now year seven after the initial observation in Europe, the varieties in the test locations are reviewed again. Usually only about two or three are found to be

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sufficiently acceptable for introduction commercially into the U.S. market. Up to that time, about \$25,000 or more has been expended winnowing the initial 200 varieties to the two or three finalists.

As much or more in costs will be incurred in budding and raising a sufficient number of plants of the finalists and bringing them to market. Obviously, it would be a foolhardy venture for a grower to undertake to introduce a new plant variety into the United States without the protection of a plant patent to enable the importer to recoup his investment costs and, of course, not all of the introduced varieties turn out to be commercially successful. The filing of applications for plant patent on each variety at the time it is first selected in Europe or elsewhere, would be cost prohibitive given the low rate of acceptability of the plants introduced from outside of the United States. And, of course, for many of the varieties which are brought into the United States, the foreign breeder has filed PBR applications or offered them for sale long prior to the time that they are proven to be satisfactory for introduction into the United States. Thus, the application of 35 USC 102(b) as suggested in the Office Action will have the effect of precluding the introduction of new plant species into the United States to the detriment of the public.

The undersigned has been informed in a telephone conversation with Primary Examiner Bruce Campell, that if stipulation to the facts of filing, publications and grants to PBR applications for a variety is made, the requirement for production will be waived and such waiver here is respectfully requested.

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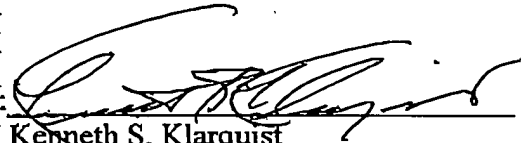
It is submitted that in view of the concessions as to the filing dates, PBR Grants and dates of sale of the variety that have made above, there is no need to supply any of the documents that might fall within the definition of those requested.

It is believed that for the reasons set forth above, the subject application is in condition for issuance of a patent and such action is respectfully requested. However, if the Examiner has any need for any additional information, he is invited to call the undersigned.

Respectfully submitted,

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